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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/367,569 | 12/21/1999 | WOLFGANG WEIDNER | 826 | 4514 |
| 7590 05/14/2008 STRIKER STRIKER & STENBY 103 EAST NECK ROAD HUNTINGTON, NY 11743 | | | | |
| | | | EXAMINER TORRES, MARCOS L | |
| | | | ART UNIT 2617 | PAPER NUMBER |
| | | | MAIL DATE 05/14/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/367,569

Applicant(s)

WEIDNER ET AL.

Examiner

MARCOS L. TORRES

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 2-5-08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2-5-08 have been fully considered but they are not persuasive.
2. Regarding applicant's argument that there is no teaching of an arrangement in which pressing a button causes a transition to a different operating state in which that a button has no function in each case the button is associated with a function for transitioning to a further operating state. It is noted the language used the arguments differs from the language used in the claims and it is unclear if the third mention of the button refers to the first or second button, thereby also having a different scope. For the above arguments Tsoi discloses the arrangement in which pressing a button causes a transition to a different operating state in which that a button has no function in each case the button is associated with a function for transitioning to a further operating state (for example note from fig. 7 and fig. 8 that by pressing the call button the phone goes to a calling mode and the second button [the one below call] changes from backspace to having no function in fig. 8).
3. Regarding applicant's argument directed to the examiner statement; the Tsoi reference as the present invention the soft or programmable buttons [control element] change according to the operating mode, under a specific operating mode the control element may a function and under another operating mode may not. Please see the above paragraph 2 for an example on how the control element may or may not have a function.

4. As to applicant's argument directed to the use of the bottom screen to show additional information, this would bring displaying the additional information in the same spot of the labels used by the control element.
5. As to applicant's argument direct to the Baals reference, Baals is only being used to show a first and second control element having no function and merely the information about said first and second operating state are assigned (see fig. 6) and Tsoi teaches when only some button have function as shown in par. 2 above.
6. Regarding applicant's arguments that the cited art must itself contain a suggestion for such modification, please see recent KSR ruling. The rejection must show that it would be obvious to one of the ordinary skills in the art at the time of the invention; it does not have to come rigidly from the cited art. And the rejection shows that is desirable to show additional information.

Claim Objections

7. Claim 22 is objected to because of the following informalities: A dependent claim cannot depend on it self. Since applicant indicated on the remarks that claim 22 should depend on claim 23, for examination purposes is going to be treated as a typographical error and the claim 22 depending on claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 23 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsoi US005633912A in view of Baals US005396547A.

As to claim 23, Tsoi discloses a radio apparatus embodied in a radio telephone (see fig. 5, item 62), comprising a display device (see fig. 7, items 74,76); a first control element and a second control element each for selecting

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and/or activating functions of the radio apparatus which are displayed on said display device (see fig.5, items 82-92; col. 6 ,lines 40-43); said first and second control elements being disposed neighboring said display device so that a local association exists between said first and second control elements and displaying of functions of the radio apparatus on said display device (see col. 2, lines 50-53), wherein a first operating state is provided in which an information about said first operating state on said display device is associated with said first control element, and in which a function for activation of a second operating state on said display device is associated with said second control element, wherein said second operating state is associated with said first operating state, and wherein in said second operating state an information about said second operating state on said display device is associated with said second control element, and in which a function for activation of said first operating state on said display device is associated with said first control element (see col. 6, lines 62-65; col. 7, lines 1-6 and fig. 7-13). Tsoi does not specifically disclose wherein said first or second control element to merely show the information about said first or second operating state are assigned. In an analogous art, Baals discloses wherein a first and second control element having no function and merely the information about said first and second operating state are assigned (see fig. 6). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to display additional information of the operating state of the device for the simple purpose of informing the user thereby enhancing user satisfaction and preventing users from entering an improper key.

As to claim 22, Tsoi discloses a radio apparatus, wherein said radio apparatus comprises third and fourth control elements for selecting and/or activating functions of said radio apparatus and wherein in said first and second operating states said third and fourth control elements are associated with respective functions of the radio apparatus which remain unchanged upon a change between said first and second operating states (note that in fig. 8 and 9 items 82 does not change; in fig. 7 and 10, item 92 does not change; in fig. 12 and 13 items 82, 84, 86 and 92 do not change).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARCOS L. TORRES** whose telephone

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number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/
Examiner, Art Unit 2617